

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESTER CORNELIUS

Appeal No. 2003-0757
Application No. 09/849,884

ON BRIEF

Before GARRIS, WALTZ, and JEFFREY T. SMITH, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 9 through 13, which are the only claims remaining in this application, as amended subsequent to the final rejection.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

¹ Appellant has submitted two amendments after final rejection which were refused entry by the examiner (see the amendments dated June 19, 2002, Paper No. 7, and July 5, 2002, Paper No. 9, which were refused entry as per the Advisory Actions dated July 1, 2002, Paper No. 8, and July 16, 2002, Paper No. 10, respectively). The amendment filed with the Brief, dated Aug. 6, 2002, Paper No. 13, was entered as per the Advisory Action dated Sep. 3, 2002, Paper No. 14 (see also the Answer, page 3), and overcomes the rejection of claim 13 under 35 U.S.C. § 112, ¶2. The amendment filed with the Reply Brief, dated Jan. 6, 2003, Paper No. 17, was entered as per the Advisory Action dated (continued...)

Appeal No. 2003-0757
Application No. 09/849,884

According to appellant, the invention is directed to a coating system which blocks ultraviolet radiation up to and including 400 nanometers, where the coating system consists essentially of two layers, with the first layer including both an ultraviolet absorber and a fluorescent material while the second layer contains an ultraviolet absorber in amounts considerably less than that in the inner or first layer (Brief, page 2).

Appellant states that "all claims stand or fall together" (Brief, page 3). Accordingly, pursuant to the provisions of 37 CFR § 1.192(c)(7)(2000), we select independent claim 9 as representative of the grouped claims and decide the ground of rejection in this appeal on the basis of this claim alone. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 9 is reproduced below:

9. An ultraviolet radiation absorbing coating system comprising:

¹(...continued)
Jan. 27, 2003, Paper No. 18, and overcomes the rejection of claims 10-12 under the second paragraph of section 112, as well as obviating the rejection of claims 9-13 under the first paragraph of section 112 due to the word "between" (see Paper No. 18).

Appeal No. 2003-0757
Application No. 09/849,884

a first synthetic resinous layer having an ultraviolet absorber with an ultraviolet absorption cut-off of about 385 nanometers, and a fluorescent material which reflects ultraviolet radiation of wave length above 385 nanometers;

and a second layer overlying said first layer having an ultraviolet absorber of approximately one-fifth the concentration of the ultraviolet absorber in said first layer, which blocks at least some of the ultraviolet reflection radiating from said fluorescent material.

The claims on appeal stand rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Answer, page 4.² We *affirm* the examiner's rejection essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

The examiner finds that the specification as originally filed fails to provide support for the claimed subject matter "a

² All other rejections stated in the final rejection have been withdrawn by the examiner in view of appellant's amendments subsequent to the final rejection (see footnote 1).

second layer overlying said first layer having an ultraviolet absorber of approximately one-fifth the concentration of the ultraviolet absorber in said first layer" (Answer, page 4, citing claim 9, ll. 4-6).

Appellant argues that support for this claim limitation is found in the examples of the specification, where the amount of ultraviolet absorber in the inner and outer layers is "roughly in a 5 to 1 ratio" (Brief, page 4). Appellant points out that the one-fifth ratio is dependent on the relative thicknesses of the inner and outer layers and it is within the skill of a worker in this art to appreciate that each coating is mixed to carry the maximum amount of ultraviolet absorptive material that it can carry without degradation, while keeping the coating as thin as possible (Brief, pages 5 and 7).

It is well settled that an *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of the first paragraph of section 112, but the originally filed disclosure must reasonably convey to one of ordinary skill in the art that appellant was in possession of the claimed subject

matter now in question. See *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). In this appeal, the examiner has satisfied the initial burden by establishing that the contested limitation is not found in the originally filed disclosure. See *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Appellant does not argue that the contested ratio is found in the original disclosure but attempts to show support for this claimed subject matter by reference to the examples (Brief, pages 4, 5 and 7).

We determine that appellant's arguments are not persuasive for the following reasons. A range in the claims may find support solely from the examples in the specification.³ However, in this appeal appellant has not persuasively shown that the examples (Examples 1-3 on pages 10-12 of the specification) provide support for the claimed ratio of "approximately one-fifth." As shown by the examiner (Answer, pages 3 and 6), the "concentration" of the ultraviolet absorbers in the Examples can be calculated as ratios that are not "approximately" one-fifth

³ See *Ex parte Jackson*, 110 USPQ 561, 562 (Bd. App. 1956).

(the examiner notes that calculations for Example 3 cannot be determined due to a lack of disclosure regarding the amount of solvent in the polysiloxane SHC 4000). Appellant has not provided any definition or guidelines for the claimed terms "approximately" or "concentration" in the original disclosure. Therefore appellant has not shown that he was in possession of the limitation in question at the time the application was filed, namely that regardless of the type of ultraviolet absorbers and the thickness of the layers that the ratio of some "concentration" of ultraviolet absorbers would be "approximately" one-fifth. The examples are only directed to specific ultraviolet absorbers with a specific film thickness (e.g., see Example 1). Appellant teaches that "[t]he thinner the layer, the higher the concentration of absorber is required." Specification, page 2, ll. 10-11. Accordingly, different thicknesses of the two layers could produce different required concentrations of absorbers to yield the desired ultraviolet absorption cut-off, i.e., the concentrations could be different than the one-fifth ratio as now claimed but still yield the

Appeal No. 2003-0757
Application No. 09/849,884

desired results. Furthermore, appellant has not shown by evidence or convincing reason that the ratio in question would apply to any of the broad classes of ultraviolet absorbers known in the art, regardless of ultraviolet absorptive activity and density (see the specification, page 2, ll. 16-18). Therefore we determine that appellant has not reasonably conveyed to one of ordinary skill in this art that he was in possession of the subject matter in question as of the filing of this application.

For the foregoing reasons and those set forth in the Answer, we determine that appellant has not reasonably conveyed to one of ordinary skill in the art that he was in possession of the now claimed subject matter at the time the application was filed. Accordingly, we affirm the examiner's rejection of claims 9-13 under the first paragraph of 35 U.S.C. § 112, for failure to fulfill the written description requirement.

Appeal No. 2003-0757
Application No. 09/849,884

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

taw/vsh

Appeal No. 2003-0757
Application No. 09/849,884

CHARLES E. TEMKO
22 MARION ROAD
WESTPORT, CT 06880